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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/613,495

07/02/2003

Tienteh Chen

200209928-1

4418

22879 7590 05/25/2007

HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

SCHWARTZ, PAMELA R

ART UNIT

PAPER NUMBER

1774

MAIL DATE

DELIVERY MODE

05/25/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES DEPARTMENT OF COMMERCE

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER
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20070523

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/613,495	Applicant(s) CHEN ET AL.	
	Examiner Pamela R. Schwartz	Art Unit 1774	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 May 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: none.
 Claim(s) objected to: none.
 Claim(s) rejected: 1-4, 6 and 7.
 Claim(s) withdrawn from consideration: 9 and 11-20.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance, because:
See attached sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
 13. ☐ Other: _____.

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1. With respect to the rejection under 35 USC 102, applicants argue that the reference does not disclose the instantly claimed porosity and the coating weight. Applicants argue that the paper of Example 5 in Table 1 of Dagan et al. is laminated with polyolefin so that its porosity is zero. This is actually consistent with applicants' claim 1 which recites and "**coated**, absorptive paperbase." Thus, the paperbase is absorptive prior to coating. The claim does not limit the coating material. Therefore, the limitation to "coated, calendered paper; coated, uncalendered paper and cast coated paper" includes all coatings used in the art. RC paper is a commonly used abbreviation for "resin coated paper" which is a well known coated paper used as supports in this art. The claim language to coated paper includes resin coated paper. Finally, claim 1 requires the coated paperbase to have "a Sheffield porosity less than approximately 10." This includes zero, which is the porosity value taught by the prior art. Applicants have not claimed "an absorptive, coated paperbase" and have not required the coated paperbase to have porosity greater than zero. Therefore, claim 1 reads on the reference as applied.

2. Applicants also argue that the coat weight per area of claim 1 is not taught by the reference. The reference discloses a coating thickness range which may be converted to grams per unit area using the density of the coating material as a conversion factor. The examiner is not in a position to do this conversion because she does not have a precise value for the density of the coating material. Therefore, in the first action, the examiner relied upon a rule of thumb used by some of ordinary skill in this art to roughly convert between the two values to show that one of ordinary skill in the art would expect

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the value ranges to overlap upon conversion. This is an inherency argument that even though the reference discloses layer thickness, it will inherently result in coating weights per unit area in a range that overlaps with that instantly claimed.

Applicants objected to the rough calculation and the examiner was unable to provide documentary sources supporting its use, so it was not repeated in the final rejection. As with the first action, the final rejection argues that the value ranges, upon conversion, are inherently overlapping. Based upon the materials and disclosed thickness range of the reference, the coating weight per unit area range recited by claim 1 should inherently be achieved. Since the examiner is not in a position to determine the actual density value of the coating material necessary to do the calculation herself, the examiner has invited applicants to overcome the rejection by demonstrating that the thickness values of the prior art would not convert to coating weight per unit area as recited by claim 1.

3. With respect to the rejection based upon applicants' admissions, contrary to applicants' assertions, the motivation for combining an ink receptive coating with a known substrate is so that the ink receptive coating can be used for its intended function, i.e. to receive ink.

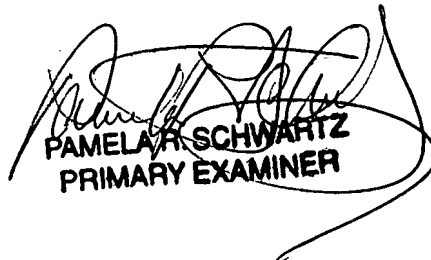
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz
May 23, 2007



PAMELA R. SCHWARTZ
PRIMARY EXAMINER